

REMARKS

Claims 1-5, 8, 9 and 11-17 are pending in this application.

No claim has been amended by this Amendment.

This response is submitted with Request for Continued Examination.

In response to Applicant's reply filed on 16 February 2006, the examiner issued an advisory action which merely states that "The prior art deems to disclose the invention."

The examiner's advisory action was not complete and did not answer all material traversed.

"Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (See MPEP 707.07(f) "Answer All Material Traversed".)

In re Zurko, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001) ("With respect to core factual findings in a determination of patentability" PTO "must point to concrete evidence in the record" and it "cannot simply reach conclusions based on its own understanding or experience or on its assessment of what would be basic knowledge or common sense").

Since the PTO has the burden of showing by substantial evidence that an applicant is not entitled to a patent, the mere conclusion of the rejection completely inappropriate; a decision on patentability must be supported by substantial evidence, not merely by speculation. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001) ("With respect to core factual findings in a determination of patentability" PTO "must point to concrete evidence in the record" and it

“cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense”).

Therefore, the examiner’s answer to the substance of the applicant’s arguments is respectfully requested if the examiner repeats the rejection.

I. Claim Rejections - 35 U.S.C. §103

Claims 1, 2, 4, 5, 8, 9, 11-14, 16, and 17 stand rejected under 35 U.S.C. §103 as being unpatentable over Ryman (U.S. Pat. No. 6,721,156) in view of European Patent Application (EP 0 746 051) and Kojima et al. or Monnett.

Claim 3 stands rejected under 35 U.S.C. §103 as being unpatentable over Ryman (U.S. Pat. No. 6,721,156) in view of European Patent Application (EP 0 746 051) and further in view of Kojima et al. or Monnett.

Claim 15 stands rejected under 35 U.S.C. §103 as being unpatentable over Ryman (U.S. Pat. No. 6,721,156) in view of European Patent Application (EP 0 746 051) and further in view of Sato et al.

The examiner’s rejection is not proper for the following reasons.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

First, the examiner failed to establish a prima facie case of obviousness because the examiner failed to show that there is some suggestion or motivation to modify the reference.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). (MPEP 2143.01)

Here, the examiner merely argued that, since Ryman '155 discloses the capacitor structure claimed but applied to the component 14 (col. 6, lines 51-54) and D'Oro '051 disclose in Figs. 2, 3 and 5 the conductor shaft (PF) being inserted in the reception tube (CC) so that the first conductor and the second conductor are assembled with each other. The examiner further argued that this combination is desirable to simplify the capacitive mechanism.

However, please note that the inner conductor 20 of Ryman '155 does not have to have the capacitance structure. That is, there is neither suggestion nor teaching that it is desirable to modify the inner conductor 20 of Ryman '155 to the capacitance mechanism structure. Specifically, Ryman '155 teaches that "[t]he inner or outer conductor 20 may further be tuned by utilizing one or more increased and/or decreased diameter segments 23, 25, 27." (See col. 4 lines 35-38 in Ryman '155.)

The first conductor and the second conductor have the capacitor structure. Claims 1 and 4 recites "the conductor shaft being inserted in the reception tube to function as electrode plates of a capacitor," claim 3 recites "the conductor shaft being inserted in the reception tube to make the conductor shaft and the reception tube as electrode plates of a capacitor," and the instant specification explains that "the DC power is not outputted to the second conductor 402, because the first conductor 400 and the second conductor 402 assembled with each other construct a capacitor" (the English translation page 10, lines 16-17).

With this function, the Ryman '155 expressly discloses a DC blocking device at col. 10, lines 16 to 26 as follows:

"A DC blocking device 80 is operatively coupled in series with the first inner conductor 20 of the through-section 12. The DC blocking device 80 blocks DC current from propagating toward the first end 15 of the through-section 12, which is the source of the RF signals, but permits the DC current to propagate in the direction toward the second end 16 of the through-section, where the active components may be located. **The DC blocking device 80 is preferably a commercially available capacitor, which is coupled in series with the inner conductor 20** of the through-section 12" (emphasis added).

The arrangement of the DC blocking device 80 is also shown in Fig. 3 of Ryman '155. According to Ryman '155's teaching, the DC blocking device is additionally coupled in series with the first inner conductor.

Therefore, the ordinary skilled person may replace the DC blocking device 80 with the structure of the resonator having an open circuit of D'Oro '051. That is, at most, the examiner may argue that the DC blocking device of Ryman '155 rather than the inner conductor 20 of Ryman '155 (which preferably utilizes one or more increased and/or decreased diameter segments (col. 4 lines 35-38 in Ryman '155) may be replaced with the structure of D'Oro '051. This is an element separately coupled in series with the inner conductor 20 of Ryman '155. Even if this blocking device is replaced with the structure of D'Oro et al. '767, the suggested capacitor is still an element separately coupled in series with the inner conductor 20 of Ryman '155. On the other hand, in the present invention, the structure of the center conductor makes an additional separate capacitor unnecessary because the center conductor has a structure to function as electrode plates of a capacitor.

Even if the two references are combined, the claimed invention is not taught or suggested.

Second, the examiner merely argued that the examiner's combination would simplify the blocking capacitive mechanism. To reach a proper determination under 35 U.S.C. §103, [k]nowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's

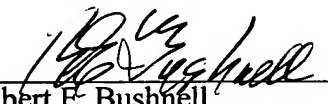
disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. It should be noted that the simplification of the manufacturing process is one of the objectives of the instant application and the prior art references does not recognize the problems, as stated above, which are solved by the present application, and does not provide a solution to achieve the above objectives.

For at least one of the above reasons, the examiner's reasoning is not proper. Withdrawal of the rejections on claims 1, 3 and 4 and their dependent claims 2, 5, 8, 9, and 11 through 17 is respectfully requested.

In view of the above, all claims are submitted to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

A fee of \$910.00 is incurred by the submission of the Request for Continued Examination (RCE) (\$790.00) and one month extension of time (\$120.00). Should the other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,


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